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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,156	03/01/2004	Katherine Woo	2043.011US1	3410
49845 7590 06/15/2009 SCHWEGMAN, LUNDBERG & WOESSNER/EBAY P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
NOTIFICATION DATE		DELIVERY MODE		
06/15/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary

Application No.

10/791,156

Applicant(s)

WOO, KATHERINE

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 4/3/2009 has been entered.

The examiner is in receipt of applicant's response to the BPAI decision mailed 2/3/2009, which was received 4/3/2009. Acknowledgement is made to the amendment to claims 1,10,18, and 22. Applicant's amendment and remarks were carefully considered, but were not persuasive. Therefore the previous rejection modified as necessitated by amendment follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Sacks (US 2002/0016765 A1).

Regarding claims 1-9

Sacks discloses a method comprising receiving, from a shopping cart application, detailed information, in response to a user request to proceed with a payment for one or more items; and upon receiving the detailed information from the shopping cart application being hosted by the merchant web-site, the merchant web site being separate from an online payment service (para 0016-0023), communicating to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items by the online payment service. See particularly paragraph [0028].

Detailed information may include item name, item number, item price, and item quantity. See paragraph [0017].

The user request to proceed with the payment is received when the user clicks a checkout button. See paragraph [0020].

Applicant's attention is directed to paragraphs [0036]-[0046] for a more detailed discussion of the method.

Regarding claims 10-24

These claims are written as apparatus, system, and computer readable medium for performing the functions recited in the method of claims 1-9. These claims are rejected under a similar line of reasoning.

Response to Arguments

Applicant's arguments filed 4/3/2009 have been fully considered but they are not persuasive. Applicant has amended the claims to change the term "external" which can be found in the specification to "separate". The examiner understands the meaning of separate to be the same as was understood by the term external therefore the previous rationale in regards to the shopping cart being external/separate apply as before.

The following is the arguments presented by the BPAI in the decision 2008-2955, pages 6-11 mailed 2/3/2009. As stated in the decision in regards to claim 1, Sacks teaches inter alia, a merchant site hosting a shopping cart and states the reasoning as follows:

"A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps. First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board's claim construction is limited to determining whether it was reasonable. In re Morris, 127 F.3d 1048, 1055 (Fed. Cir. 1997). Secondly, the Board must compare the construed claim to a prior art reference and

make factual findings that "each and every limitation is found either expressly or inherently in [that] single prior art reference." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998)." In *re Crish*, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

Claim 1 defines a method comprising two steps. In the first step, a virtual shopping cart application sends detailed information concerning one or more items placed by a user in a virtual shopping cart in response to a user request to proceed with a payment for the one or more items. According to claim 1, the virtual shopping cart application is "external" to an online payment service and the virtual shopping cart is hosted by a "merchant" web site. In the second step, once the detailed information concerning one or more items placed by a user in a virtual shopping cart is received from the shopping cart application, one or more user interfaces that facilitate processing of the payment for the one or more items is communicated to the user via a communications network. According to claim 1, the one or more user interfaces allows the user to view the contents of the virtual shopping cart.

No term used in the claim is provided with a corresponding definition in the Specification. Accordingly, we look to the words of the claim, giving each their ordinary and customary meaning. "Claim construction begins, as it must, with the words of the claims. See *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615,619-20 (Fed. Cir. 1995)." *Vehicular Techs. Corp. v. Titan Wheel Int'l*, 141 F.3d 1084, 1088 (Fed. Cir. 1998). But we determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims "their

broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004). Our interpretation of disputed language must be reasonable in light of all the evidence before the Board. See In re Morris, 127 F.3d 1048, 1055 (Fed. Cir. 1997) ("The question then is whether the PTO's interpretation of the disputed claim language is "reasonable." ... We conclude that the PTO's interpretation is reasonable in light of all the evidence before the Board.").

As it is commonly understood, a virtual shopping cart application is an application which facilitates a user selecting an item from an online catalogue and transferring the selected item to a virtual shopping cart where the item sits until such time the user decides to check-out and proceed to pay for the selected items in the cart? In that respect, the first step of the claimed process reiterates the generally-understood operation of a virtual shopping cart application.

The second step of the claimed process calls for communicating an interface to the user to facilitate processing of the payment and allow the user to view the contents of the virtual shopping cart once selected items for purchase are placed in the shopping cart. Since a web page is a well known example of an interface, the second step of the claim broadly covers presenting to the user a web page to both view the contents of the virtual shopping cart and facilitate processing for the payment of selected items in the cart.

As for the limitation that the virtual shopping cart application is "external" to an online payment service, given "external"'s ordinary and customary meaning (FF 4), the claimed method requires the virtual shopping cart application to be outside an online payment service (e.g., PayPal®, see Specification [0003]).

As for the limitation that the virtual shopping cart is hosted by a "merchant" web site, given "merchant"'s ordinary and customary meaning (FF 7), the claimed method requires the virtual shopping cart to be hosted by a web site pertaining to trade.

Putting it all together, the broadest reasonable construction of claim 1 in light of the Specification as it would be interpreted by one of ordinary skill in the art is that it describes a method for using a virtual shopping cart application, situated outside an online payment service, to operate a virtual shopping cart hosted by a merchant web site to present to the user of the shopping cart a web page to both view the contents of the virtual shopping cart and facilitate processing for the payment of selected items in the cart.

We turn now to the second step of the anticipation analysis.

Sacks (FF 9-12) shows using a payment processor comprising various components, including a "payment processing module." The "payment processing module" of the payment processor interfaces with external financial entities and is thus outside an online payment service. This would appear to meet the claimed limitation that the virtual shopping cart application is "external" to an online payment service. The Sacks payment processor further forms a website operated by a third-party to process a buyer's payment for a transaction made with an online seller. It comprises a seller

interface and a buyer interface and the buyer interface may be used to update a shopping cart. See [0032]. The shopping cart (e.g., a buyer's shopping cart) may be stored in a database on the payment processor and managed by the payment processor (see [0028]). Thus, the payment processor hosts the shopping cart. Since Sack's third-party payment- processing website hosts the shopping cart and is used in trade, Sack's website represents a "merchant" website hosting a shopping cart and thus appears to meet the claim limitation the virtual shopping cart is hosted by a "merchant" web site. Finally, as the Examiner has explained (Answer 3), Sacks describes its method as receiving information from the shopping cart (including e.g., item name, see [0017]) in response to a user request to proceed with payment for a selected item and communicating to the user an interface to facilitate processing of the payment (see [0016]). Accordingly, it would appear that Sacks describes the operation of a virtual shopping cart application to the extent claimed.

Having compared the claim, in its broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art, to Sacks and finding that all the limitation of the claim are expressly described therein, we agree with the Examiner that Sacks anticipates the claimed subject matter."

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey A. Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Primary Examiner, Art Unit 3625